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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,715	08/03/2001	Joseph Robinson	SCIPERIO	5070

7590

11/06/2002

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EXAMINER

EVANS, GEOFFREY S

ART UNIT

PAPER NUMBER

1725

DATE MAILED: 11/06/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,715

Applicant(s)

ROBINSON ET AL.

Examiner

Geoffrey S Evans

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08/03/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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DETAILED ACTION

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the support coupled to the milling laser (recited in claim 1), the holder for the microscope (recited in claim 4), and a bracket for supporting the transmission electron microscope or the focused ion beam (recited in claim 7) must be shown or the feature(s) canceled from the claim(s). The "support" is not the micro-manipulator according to the language of claim 4. No new matter should be entered. The drawings are also objected to because in figure 1 the black box identified by the numeral 16 should be labeled as "Microscope", element 18 as "Pattern Recognition Assembly", element 12 as "Micro-Manipulator", element 20 as "LASER", element 14 as "PLATFORM", elements 19 and 22 each as "Micro-Manipulator", element 12 as "ION BEAM GENERATOR" instead of as "FIB", element 28 as "TRANSMISSION ELECTRON MICROSCOPE" instead of as "TEM". Please note under 37 CFR 1.83(a) black boxes must be labeled (and not with two letter acronyms).

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. Claim 5 is objected to because of the following informalities: In claim 5 on lines 1 and 2 "is silicon wafer" should be "is a silicon wafer". Appropriate correction is required.

3. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1 it is unclear from the sentence whether

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the support is coupled to only the milling laser or whether the support is coupled to the microscope, a pattern recognition assembly and the milling laser. It is unclear what is meant in claim 7 by "focused ion beam source or FIB" as they appear to be identical.

Please note that Acronyms are not permitted in the claims. Please remove all references to "FIB" and "TEM" in the claims and use "focused ion beam" or "transmission electron microscope".

4. Claims 1-27 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Japan Patent No. 11-160,210 forms a sample by a laser beam treatment followed by an ion beam treatment. Ueki et al. in Japan Patent No. 9-96,595 forms using a laser beam a sample for transmission electron microscope (TEM). Japan Patent No. 11-145,087 uses an ion beam generator or a laser beam to treat a sample. Inchinose in JP2000-329,663A forms a sample with ion beam and laser treatment. Shoffner in U.S. Patent No. 6,300,631 uses an ion beam to cut a membrane.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey S Evans whose telephone number is (703)-308-1653. The examiner can normally be reached on Mon-Fri 6:30AM to 4:00 PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (703)-308-3318. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.



Geoffrey S Evans
Primary Examiner
Art Unit 1725

GSE
November 4, 2002